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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,333	10/12/2001	Jeffrey C. Hawkins	21495-05942	9245
758	7590	12/07/2004	EXAMINER ZHOU, TING	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			ART UNIT 2173	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/976,333

**Applicant(s)**

HAWKINS ET AL.

**Examiner**

Ting Zhou

**Art Unit**

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/15/04, 9/23/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The amendment filed on 24 August 2004 have been received and entered. The applicant has amended claims 1, 6, 11 and 16 and added new claims 17-30. Claims 1-30 as amended are pending in the application.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-8, 11-13 and 16-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Ghassabian U.S. Publication 2004/0047505.

Referring to claims 1, 6, 11, 16, 21 and 26, Ghassabian teaches a handheld device comprising a menu bar including a plurality of menus (Figures 14a-15h); a set of items associated with each menu of the plurality of menus (Figure 15f-15g); a display button to cause the menu bar including the plurality of menus to be displayed (positioning the mouse in menu mode position for displaying a plurality of menu lists) (page 13, paragraphs 0230-0232); a first scroll button to cause a cursor to navigate within a menu when no selection command has been received for the menu (when the user simply positions the mouse in menu mode, without

selecting a particular menu, users can use the mouse to navigate within the list of menus displayed) (page 13, paragraphs 0231-0232) and to highlight a desired menu item within the menu (desired menu items are highlighted, or represented by the menu selecting indicator means) (page 13, paragraphs 0231-0232 and Figures 14a-15h); and a second scroll button, wherein when the cursor is highlighting one of the menus, the second button causes the cursor to navigate from one menu to another (when the menu bar selecting indicator is highlighting one of the menu bar titles, the mouse can be used to navigate from one menu title to another) (pages 13-14, paragraphs 0232-0233); and when the cursor is highlighting a menu item other than the first menu item in a menu, and no selection command has been received for the menu, the second button causes the cursor to navigate within the menu (when the user has selected for the system to enter function selection mode, without a selection command for a particular menu, users can use the cursor to navigate within the opened menu bar in order to select a desired function) (page 14, paragraph 0233 and Figures 14a-15h).

Referring to claims 2, 7 and 12, Ghassabian teaches a third button to cause the device to display the plurality of menus (upon opening a word processing program for example, and selecting the menu mode, users can navigate between a plurality of displayed menus) (page 13, paragraph 0230-0231).

Referring to claims 3, 8 and 13, Ghassabian teaches an execute button to execute the highlighted item (when the user pushes the mouse to the inside direction and clicks it while the indicator is at the desired function, the system executes, or selects and displays the highlighted or indicated function) (page 14, paragraph 0233).

Referring to claims 17, 22 and 27, Ghassabian teaches the first button is a scroll-up button (page 20, paragraph 0288 and Figure 6).

Referring to claims 18, 23 and 28, Ghassabian teaches the second button is a scroll-down button (page 20, paragraph 0288 and Figure 6).

Referring to claims 19, 24 and 29, Ghassabian teaches the first button is a right arrow button (page 20, paragraph 0288 and Figure 6).

Referring to claims 20, 25 and 30, Ghassabian teaches the second button is a left arrow button (page 20, paragraph 0288 and Figure 6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4-5, 9-10 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghassabian U.S. Publication 2004/0047505, as applied to claims 1, 6 and 11 above, and further in view of Will U.S. Patent 5,825,353.

Referring to claims 4, 9 and 14, Ghassabian teaches all of the limitations as applied to claims 1, 6 and 11 above. However, although Ghassabian teaches the handheld device being used for telephonic functions (Ghassabian: page 20, paragraphs 0283-0285), Ghassabian fails to explicitly teach the highlighted item being a telephone number. Will teaches a handheld device

with telephonic functions and displays a plurality of menus (Will: Figure 1) similar to that of Ghassabian. In addition, Will further teaches the highlighted item being a telephone number (Will: column 3, lines 54-59, column 4, lines 33-37, column 13, lines 9-22 and Figure 12c). It would have been obvious to one of ordinary skill in the art, having the teachings of Ghassabian and Will before him at the time the invention was made, to modify the method of navigating among a plurality of menus of Ghassabian to include the telephone numbers of Will. One would have been motivated to make such a combination in order to provide a fast and easy user interface for miniature handheld devices such as cellular to efficiently locate and retrieve stored telephone numbers.

Referring to claims 5, 10 and 15, Ghassabian, as modified, teaches a button to dial the telephone number (Will: the "Dial" button represented by reference character "201" in Figure 12c).

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

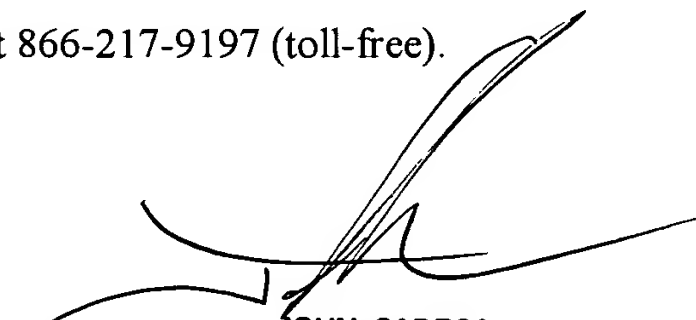
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-4058.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22 November 2004



**JOHN CABECA**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100